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**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/319,828	06/11/99	GUENTER	W GUENTER-1 (P)

COLLARD & ROE
1077 NORTHERN BOULEVARD
ROSLYN NY 11576-1696

IM22/0315

EXAMINER

AHMED, S

ART UNIT	PAPER NUMBER
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1773

DATE MAILED:

03/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/319,828

Applicant(s)
Walther

Examiner
Sheeba Ahmed

Group Art Unit
1773



☒ Responsive to communication(s) filed on Feb 26, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 15-31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 15-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response to Amendment

1. Amendments to the above-identified application have been entered. Claims 1-14 have been canceled. New claims 15-31 have been added.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

2. Claims 15-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites a plastic layer comprising materials having release properties wherein the materials having release properties are arranged within the plastic layer. It is unclear what is meant by "arranged within the plastic layer". Are the "materials having release properties" oriented within the plastic layer? Furthermore, the use of the phrase "a plastic layer" is ambiguous in this instance since it is unclear whether there are other layers or not given that the definition of the word "layer" is "one thickness lying over or under another" or "stratum". The Examiner suggests replacing the phrase "plastic layer" with "plastic film" to further clarify the claim language.

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Claim 16 recites that the plastic layer comprises "basic polymers having properties that are modified". It is unclear what is meant by "basic polymers" or by "properties that are modified". No definition of "basic polymers" or "properties that are modified" has been provided in the Specification or the claims.

Claim 18 is dependent on claim 15 and recites "the materials incorporated as additives". There is no antecedent basis for "the materials incorporated as additives" in claims 15 or 18.

Claim 19 recites that "the materials having release properties are firmly embedded into a matrix of the plastic layer". The term "firmly", as pointed out in the previous Office Action, is a relative term which renders the claim indefinite since it is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 23 recites "a method of making a plastic layer having an adhesive layer and a release layer, comprising the steps of: adding materials containing release properties to the plastic layer; and polymerizing the material containing release properties into the plastic layer". It is unclear whether the plastic layer is a multilayer structure comprising an adhesive layer and a release layer separated by a plastic layer or a single film having a first side with adhesive properties and a second side with release properties. The Examiner, again, suggests replacing the phrase "plastic layer" with "plastic film" to further clarify the claim language. It is further unclear what is meant by "material containing release properties" and "polymerizing the material containing release properties into the plastic layer". For clarification and consistency, the Examiner suggests

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amending “material containing release properties” to “material having release properties”. The phrase “polymerizing the material containing release properties into the plastic layer” is ambiguous since it is unclear whether “the material containing release properties” is being polymerized or the “plastic layer” is being polymerized. Clarification is required.

Claim 25 recites that the plastic layer is produced from “a master batch”. It is unclear what is meant by “a master batch”.

Claim 26 further recites “the step of co-extruding the plastic layer”. It is unclear what is coextruded with the plastic layer?

Claim 31 recites that “a release layer” is “embedded in the first side of the plastic layer before extrusion”. It is unclear whether the “release layer” is extruded or the “plastic layer” is extruded. Clarification is required.

Claim Rejections - 35 USC § 102

3. Claims 15-17, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Berger et al. (US 3,726,710).

Berger et al. disclose a curable silicone release composition used as a release layer *(equivalent to the plastic layer of the claimed invention)* and a paper substrate *(equivalent to the carrier layer of claim 21)* coated with the silicon release composition (Column 1, lines 7-11). The silicone release composition comprises a mixture of an organopolysiloxane starting material *(wherein one component is equivalent to the basic polymer of claim 16 and the other is*

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equivalent to the silicone compound of claim 17)(Column 3, lines 42-48). All limitations of the claimed invention are disclosed in the above reference.

4. Claims 15, 16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Friedman et al. (EP 0622411A2).

Friedman et al. disclose polypropylene (*equivalent to the basic polymer of claim 16*) and polymethylpentene (*equivalent to the polyolefin compound of claim 18*) blends and their use as release sheets (*equivalent to the plastic layer of the claimed invention*) (Page 1). The release properties of the release sheet can be further adjusted by employing one or more inorganic fillers (*equivalent to the inorganic fillers of claim 20*) (Page 3). The blend can be used to form articles or sheets for embossing or can be extruded to produce release liners and release films and as coatings for polymer liners (Page 4). All limitations of the claimed invention are disclosed in the above reference.

5. Claims 15-17, 19, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Higgins (US 5,932,352).

Higgins discloses a release film comprising a polymeric film substrate (*equivalent to the carrier layer of the claimed invention*) and a release layer (*equivalent to the plastic layer of the claimed invention*) formed from a silicone resin (*equivalent to the silicone compound of the claimed invention*) and a polymer (*equivalent to the basic polymer of the*

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claimed invention)(Column 1, lines 57-61). The silicone resin may be a polysiloxane (Column 4, lines 35-37). The release film may vary in thickness depending on the application and may be in the range of 5 to 350 μ m (Column 8, lines 43-48). All limitations of the claimed invention are disclosed in the above reference.

6. Claims 15, 16, 18, 19, 21, and 23-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Adamko et al. (US 5,948,517).

Adamko et al. discloses release films *(equivalent to the plastic layer of the claimed invention)* made of thermoplastic materials such as a blend of two or more LLDPE's *(wherein one component is equivalent to the basic polymer and the other is equivalent to the polyolefin additive material of the claimed invention)* that may be applied to a polymeric adhesive surface *(equivalent to the carrier layer of claim 21 and the adhesive layer of claim 23)* wherein the adhesive surface may be textured *(thus meeting the limitation that the carrier layer may be embossed)* (Column 3, lines 15-18 and Column 4, lines 60-64). The invention may be a pressure sensitive adhesive tape having an adhesive layer and a release film liner. The film may be cast or extruded and preferably has a thickness of 0.01 to 0.5 mm (Column 5, lines 45-48). All limitations of the claimed invention are disclosed in the above reference.

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Claim Rejections - 35 USC § 103

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al. (US 3,726,710).

Berger et al., as discussed above, disclose the claimed invention but do not specifically state that the plastic layer has a thickness of 5 μ m. However, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to have determined the optimum thickness of the plastic layer through routine experimentation in the absence of a showing of criticality in the claimed size.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman et al. (EP 0622411A2).

Friedman et al., as discussed above, disclose the claimed invention but do not specifically state that the plastic layer has a thickness of 5 μ mm. However, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to have determined the optimum thickness of the plastic layer through routine experimentation in the absence of a showing of criticality in the claimed size.

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamko et al. (US 5,948,517).

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Adamko et al., as discussed above, disclose the claimed invention but do not specifically state that the plastic layer has a thickness of 5 μ m. However, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to have determined the optimum thickness of the plastic layer through routine experimentation in the absence of a showing of criticality in the claimed size.

Response to Arguments

10. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. However, the Examiner is addressing the arguments as they may apply to the new rejections.

Applicants traverse the rejection based on Berger and Higgins and submit that Berger does not disclose a plastic layer being jointly extruded with the material forming the releasing properties and Higgins does not disclose the insertion of the release layer before extruding the plastic layer. In response, the Examiner would, again, like to remind the Applicants that the determination of patentability for the product claims containing process limitations is based on the product itself and not on the method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and also see MPEP 2113. In this case, the product (i.e., the plastic layer) is the same despite the process limitations. Applicants further argue that only a small amount of material for producing the releasing

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properties is used in the present invention as compared to Berger's invention and that the present invention prevents the releasing material from diffusing into the adhesive. However, the Examiner would like to point out that the limitations on which the Applicants are relying are not stated in the claims. It is the claims that define the invention and it is the claims, not the Specification, that are anticipated or unpatentable.

With regards to the rejection based on Friedman, the Applicants assert that Friedman does not anticipate or render obvious the present invention. In response, the Examiner notes that the Applicants have failed to clearly point out the patentable novelty and have failed to show how the amendment avoids the applied rejection.

In response to the Applicants argument that Adamko does not include a material for producing releasing properties disposed in the plastic layer, the Examiner would like to direct the Applicants attention to Column 3, lines 15-18 and Column 4, lines 60-64 which discloses release films made of thermoplastic materials such as a blend of two or more LLDPE's wherein the Examiner has taken the position that one component is equivalent to the basic polymer and the other is equivalent to the polyolefin additive material of the claimed invention.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

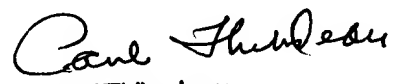
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Sheeba Ahmed whose telephone number is (703) 305-0594. The Examiner can normally be reached on Monday-Friday from 8am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paul Thibodeau, can be reached at (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5436.

SA
Sheeba Ahmed
March 8, 2001


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700